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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**
Naohito TOMOE	
Serial No. 09/225,245	Appeal No.:
Filed: January 4, 1999	Group Art Unit: 2682
For: DEVICE FOR AND METHOD OF DETECTING INTERFERENCE WAVES	Examiner: Nguyen T. Vo

12 Brief 1-11-02

REPLY BRIEF

Assistant Commissioner For Patents
Washington, D.C. 20231

Dear Sir:

This is a reply to the Examiner's Answer dated November 6, 2001 in the appeal from the final rejection in the subject patent application.

At page 3 of the Answer, the Examiner asserts that he is entitled to ignore the disclosure of the Yoshimi reference as a whole and instead treat the selected isolated discussion of the background of Yoshimi's disclosure as a separate "publication that discloses the above conventional system." The Examiner's position is unavailing because it is contrary to the law.

As established in Appellant's main brief, the binding legal precedent requires that a prior art reference be considered as a whole in determining the obviousness of a proposed combination or modification of the prior art under 35 U.S.C. § 103. Bausch &

Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F. 2d 443, 230 USPQ 416 (Fed. Cir. 1986). Consideration of the prior art as a whole prohibits the Examiner from excising selected portions of the Yoshimi reference and pretending that such excised portions are a separate "publication" as the Examiner has done here, while conveniently ignoring the teaching of the Yoshimi reference and what that teaching would have suggested to those of ordinary skill in the art.

In emphasizing that he "never relies on Yoshimi's own invention," the Examiner acknowledges that the proposed modification of the prior art cannot be obvious under 35 U.S.C. § 103 if the Yoshimi reference is properly considered as a whole in light of the level of ordinary skill in the art.

The Examiner further continues to assert that claim 1 does not recite detecting an interference wave signal on a downlink channel from a base station to a mobile station. Because this is a question of claim interpretation, which is a matter of law, no further argument on this point is necessary as the Board can make its own independent determination of the legal scope of the claims on appeal. However, the Examiner's assertion regarding the scope of the claims does not represent an exception to the rule of law concerning the proper consideration to be given to a prior art reference in rendering a determination of obviousness under 35 U.S.C. § 103. Thus, even if the claim limitation in dispute "is disclosed by Yoshimi, column 1 lines 60-67 and column 2 lines 1-12," as asserted in the Answer, the claimed invention is neither anticipated by Yoshimi under 35 U.S.C. § 102 nor obvious under 35 U.S.C. § 103 because Yoshimi neither discloses each and every limitation of the claims as a whole, nor suggests any modification of the prior art to those of ordinary skill in the art.

For the foregoing reasons and the reasons set forth in the main Brief on Appeal filed October 16, 2001, the Honorable Board is requested to reverse the outstanding grounds of rejection and to direct the passage of this application to allowance.

Please charge any fee or credit any overpayment pursuant to 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 02-2135.

Respectfully submitted,

ROTHWELL, FIGG, ERNST & MANBECK, p.c.

By Vincent M DeLuca

Vincent M. DeLuca
Attorney for Appellant
Registration No. 32,408

555 Thirteenth Street, N.W.
Suite 701, East Tower
Washington, D.C. 20004
Telephone: 202-783-6040

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing REPLY BRIEF in Serial No. 09/225,245 was transmitted in triplicate by facsimile transmission on Monday, January 07, 2002 to 703-872-9315.

Vincent M DeLuca

Vincent M. DeLuca
Registration No. 32,408
Attorney for Appellant